

REMARKS

Generally

Claims 1-9 are pending in the application. In this response, claims 1, 3 and 9 have been amended. Exemplary support for the claim amendments can be found throughout the specification and claims as originally filed. See, for example, page 8, lines 13-15 of the present specification.

It should be noted that lines 13-15 at page 8 of the present specification have been amended for clarity. In particular, the term "dyes" has been replaced with "groups". The foregoing amendment is consistent with the disclosure in lines 8-12 at page 8 of the present specification.

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

Rejection under 35 U.S.C. § 112

Claim 9 has been rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. As suggested by the Examiner, the term "using" has been replaced with "utilizing" in claim 9. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph should be withdrawn.

Obviousness-type Double Patenting Rejections

Claims 1-9 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-10 and 19 of U.S. Application Serial No. 11/631,942; claims 1-9 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-11, 22 and 24 of U.S. Application Serial No. 11/632,653; claims 1-5, 8 and 9 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 2, 6, 7, 9 and 11 of U.S. Application Serial No. 10/714,945; claims 1-9 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 4-9 of U.S. Application Serial No. 10/576,941; claims 1-5, 8 and 9 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 2 and 4 of U.S. Application Serial No. 10/578,229; claims 1-5, 8 and 9 have been rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 2 and 12 of U.S. Patent No. 7,048,790;

claims 1-5, 8 and 9 have been rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 5, 6, 8 and 10 of U.S. Patent No. 7,211,133; claims 1-9 have been rejected on the ground of nonstatutory obviousness-type double patenting over claim 1 of U.S. Patent No. 7,267,715; claims 1-9 have been rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-3 and 15 of U.S. Patent No. 7,037,365; claims 1-5, 8, and 9 have been rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 2, 12, and 13 of U.S. Patent No. 7,029,523; and claims 1-5, 8 and 9 have been rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-3, 6, 8-10, 13, 17, and 18 of U.S. Patent No. 7,303,272.

Applicants believe that the presently pending claims are patentable over the claims of the cited references.

However, if necessary, Applicants will consider submitting terminal disclaimers over the cited references when allowable subject matter has been agreed upon in the presently pending claims. It should be noted that the filing of a Terminal Disclaimer is not to be construed as an admission of the propriety of the rejection on obvious double patenting. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

Rejections under 35 U.S.C. § 102

Claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by WO 2004/029166 (U.S. Patent No. 7,303,272 is the English language equivalent of WO 2004/029166); claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 1420051; claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by JP 2004/149558; claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2004/0154496; claims 1-9 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2007/0266890; claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. US 2007/0101899; claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,048,790; claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,211,133; claims 1-9 have been rejected under 35 U.S.C. § 102(e) as allegedly

being anticipated by U.S. Patent No. 7,267,715; claims 1-9 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,037,365; and claims 1-5, 8, and 9 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,029,523. These rejections are respectfully traversed.

Amended independent claim 1 recites a black ink composition comprising a water soluble dye containing a single compound showing an absorption maximum at 440 to 540 nm with a half-value width of 90 nm to 200 nm for a visible region absorption spectrum in water, wherein the single compound has from 4 to 6 azo groups in one molecule.

Applicants respectfully submit that the cited references fail to disclose each and every feature recited in amended independent claim 1. In particular, Applicants respectfully submit that the cited references fail to disclose a single compound having from *4 to 6 azo groups in one molecule*, as presently recited in amended independent claim 1.

In view of at least the foregoing, Applicants respectfully submit that the rejection of the claims should be withdrawn.

Conclusion


Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below if any issues remain in this matter, or if a discussion regarding any portion of the application is desired by the Examiner.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,
BUCHANAN INGERSOLL & ROONEY PC

Date: October 14, 2008

By: 
Shrutti S. Costales
Registration No. 56,333

Customer No. 21839
P.O. Box 1404
Alexandria, VA 22313-1404
(703) 836-6620